

REMARKS

Claims 1-24 and 42-43 remain withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to a non-elected invention. Claims 25-27, 29, 31-41, 44-50 and 53 are currently pending in the application. Reconsideration of the outstanding rejections is requested for the reasons that follow.

Claim Amendments

Without conceding to the Examiner's opinion, and only in the interest of expediting the proceedings, the following claim amendments have been made. The applicant reserves the right to re-introduce any amended/deleted subject matter at any time during the proceedings and/or in one or more divisional applications.

Claims 25 and 26 have been amended to recite "the steps of" and "at least one" ditag for clarity. Claims 25 and 26 have also been amended to define the full-length cDNA transcript, as indicated. Written description support for these amendments may be found at least at paras. [0012] and [0014] of the published specification and Figures 1-2, which depict that the full-length cDNA transcript and respective tags, including the transcription start site and the transcription endpoint. No new matter is added.

Claim 31 has been amended to delete "to detect gene expression". Written description support for the amended claim 31 may be found at least at para. [0142] of the published specification. No new matter is added.

Claims 32, 44 and 45 have been amended to recite “at least one”, in view of the amendment to independent claim 26. No new matter is added.

Claims 33 and 37 have been amended to delete “coding sequence of the”, in view of the amendment to independent claim 26. No new matter is added.

Claims 39 and 40 have been amended to depend from claim 26 and also as indicated, for clarity. Written description support for these amendments may be found at least at paras. [0073] and [0147] of the published specification. No new matter is added.

Claim 49 has been amended to recite “a Mmel site”, as indicated. There is written description support for this amendment in the published specification at least at para. [0187]. No new matter is added.

The applicant respectfully submits that the amendments do not extend beyond the application as filed.

Claim Objection

The Examiner has objected to claim 49 for including the limitation “the type II restriction site is Mmel.” Specifically, the Examiner argues that the limitation should refer to an Mmel site, rather than Mmel itself, which is a restriction enzyme. As discussed above, claim 49 has been amended as suggested by the Examiner.

Accordingly, this objection has been obviated and should be withdrawn.

Claim Rejections under 35 USC § 112, second paragraph

The Examiner has rejected claims 25-27, 29, 31-41, 44-50 and 53 under 35 USC § 112, second paragraph, as being indefinite. Specifically, the Examiner argues that the claims initially refer to “at least one ditag” and then subsequently refer to “the ditag.” The Examiner notes that it is unclear if these limitations are referring to the same thing. It is respectfully submitted that the present amendments to claims 25-26, 39, 40-41 and 44-45, discussed above, address the antecedent basis rejection for these claims, and their respective dependent claims 27, 29, 31-39 and 46-50 and 53. Accordingly, this rejection should be withdrawn.

The Examiner has rejected claim 31 under 35 USC § 112, second paragraph, as being indefinite. Specifically, the Examiner argues that it is unclear how the limitation “to detect gene expression” further limits the activities embraced by claim 31. Claim 31 has been amended, as discussed above, to remove this limitation. Accordingly, this rejection has been obviated and should be withdrawn.

The Examiner has rejected claim 32 under 35 USC § 112, second paragraph. Specifically, the Examiner argues that the limitation “the ditag nucleotide sequence” lacks antecedent basis. Claim 32 has been amended, as discussed above, to clarify the language of this limitation. Accordingly, this rejection has been obviated and should be

withdrawn.

The Examiner has rejected claims 33-37 under 35 USC § 112, second paragraph, as being indefinite. Specifically, the Examiner argues that the references to steps (i) and (ii) in claims 33 and 37 lack antecedent basis because claim 26 does not refer to these limitations as “steps.” As discussed above, claim 26 has been amended as suggested by the Examiner to recite “comprising the steps of.” Accordingly, this rejection has been obviated and should be withdrawn.

The Examiner has rejected claims 39-41 under 35 USC § 112, second paragraph, as being indefinite. Specifically, the Examiner argues that the limitation “two joined first and second sequence tags,” and the limitations referring to the 5' and 3' terminus sequence are unclear, as well as various other limitations. The applicant disagrees with the Examiner's interpretation of the claims. However, solely in the interest of expediting prosecution, claims 39-41 have been amended to clarify the language. In particular, claim 39 has been amended to depend from claim 26 and to recite mapping to a “genome sequence.” This present claim is fully supported by the description and it is respectfully submitted that from a reading of at least paras. [0073] and [0147] of the published specification, the person skilled in the art will understand the scope of this claim relating to mapping of the ditags to a genome sequence to be clear. Further, claim 40 has been amended as indicated. It is respectfully submitted that this present claim clearly defines the method of preparing the ditag according to claim 26,

and determining and comparing its sequences with a genome sequence and a gene database to identify potential new genes through differential matching. Accordingly, the scope of dependent claim 41 is also clear. Therefore, this rejection has been obviated and should be withdrawn.

Claim Rejections under 35 USC § 112, first paragraph

The Examiner has rejected claims 25-27, 29, 31-38, 44-50 and 53 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner argues that the limitations relating to a full-length coding sequence are not described in the specification. The applicant disagrees with the Examiner's interpretation of the claims. However, solely in the interest of expediting prosecution, claims 25 and 26 have been amended, as indicated above, to clarify the structure of the full-length cDNA as including the 5' transcription start site at its 5' terminus and the 3' transcription endpoint at its 3' terminus. As acknowledged by the Examiner, there is written description support for full-length cDNA transcript at paras. [0012] and [0014] of the published specification. Further, it is respectfully submitted that Figures 1-2 clearly depict and provide support for a full-length cDNA molecule including the 5' transcription start site and the 3' transcription endpoint. In one embodiment of the present method, a ditag is prepared from such a full-length cDNA transcript comprising a first 5' tag including the 5' transcription start site and a second 3' tag including the 3' transcription endpoint. Such a ditag delineates the starting point and ending point of transcripts (see para. [0147] of the published specification). Accordingly, it is

respectfully submitted that there is full written description support for the present claims.

The applicant also notes that the Examiner has acknowledged in the office action dated 29 September 2009 that paras. 22 and 28 of the Ren declaration are persuasive to the novelty and non-obviousness of similar subject matter. The Examiner has been made aware that the corresponding JP application 2004-271022 has been accepted for a similar subject (see office Action dates 12 April 2010). In addition, claims 40-41 were previously allowed in the office actions dated 29 September 2009 and 12 April 2010.

Accordingly, as the indefiniteness and written description objections have been addressed, it is respectfully submitted that the present claims are now in order for allowance.

Please charge any additional fees or credit any overpayments to Deposit Account No. 02-2135.

Respectfully submitted,

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